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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/403,224 10/15/99 MATSUMOTO

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EXAMINER

WILSON, D.

ART UNIT

PAPER NUMBER

1713
DATE MAILED:

05/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application N .

09/403,224

Applicant(s)

MATSUMOTO, KOJI

Examiner

D. R. Wilson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112, Second Paragraph

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The language of Claim 1 is indefinite because based upon the specification, acetone and tert.-butanol are decomposition products of the organic peroxide. As such, they would always be present in total amounts less than 1 mole per mole of the decomposed products. Hence, the limitation of the claim makes no sense.
4. Claim 6 is indefinite because the contribution of secondary curing to a compression set value would be dependent on the conditions of primary curing as well as the conditions of secondary curing, none of which is specified in the claim. It is also indefinite because of the ambiguous meaning of "primarily" and secondarily" cured products. It is suggested that language such as "product from primary curing", and "product from secondary curing" be used.

Claim Rejections - 35 USC § 102(b) - 35 USC § 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO'995, Takemoto, or Albano. WO'995 is an equivalent to JP'878.

9. WO'995 discloses compositions such as are instantly claimed, e.g., see Claim 1. The exemplified fluoroelastomer contains iodine within the limits of instant Claim 2, i.e., 5200 ppm, or 0.05 wt.%. In as much as t-butyl cumyl peroxide and dicumyl peroxide are specifically taught at page 3, lines 9-13, their use would clearly be envisioned.

10. Takemoto discloses elastic fluorine containing polymers comprising bonded iodine which can be cross-linked (col. 1, lines 22-45). The iodine content is preferably 0.01 to 5 wt.% (col. 1, lines 51-58). Specific examples of the cross-linking agent include di-t-butylperoxide, t-butycumylperoxide and dicumylperoxide (col. 4, line 62 to col. 5, line 10). As these peroxides, which are the same as used by applicant, are specifically disclosed their use would be immediately envisaged. The inclusion of 0.1 to 10 parts by weight of polyfunctional unsaturated compounds is also specifically disclosed (col. 5, lines 11-26).

11. Albano discloses curable fluoroelastomer compositions of fluoroelastomers containing preferably 0.01 to 2.5 wt.% of iodine (col. 1, lines 57-64). Curing with di-t-butylperoxide, and dicumylperoxide is specifically disclosed (col. 4, line 64 to col. 5, line 6). As these peroxides, which are the same as used by applicant, are specifically disclosed their use would also be immediately envisaged. The inclusion of 0.1 to 1 wt.% of polyfunctional unsaturated compounds is also specifically disclosed (col. 5, lines 7-18).

12. As the compositions of WO'995, Takemoto and Albano are the same as applicants it is reasonable to assume that they meet any limitations of decomposition products and contribution of compression set due to secondary curing.

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It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594.

Art of Interest/Technological Background

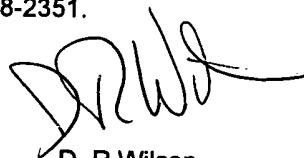
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Abe, Carlson, Ueta and Wachi all disclose compositions such as are instantly claimed and could be used as a basis for rejecting the claimed subject matter. Wlassics is considered to be cumulative to Albano. Additionally, it is noted that JP'776, JP'391 and JP'879 were each cited in the international search report as "X" references, and their full teachings need to be reviewed when an English translation becomes available. Note that JP'879 is available as a reference until the priority document is perfected with an English translation (See M.P.E.P. § 201.15.)

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R Wilson
Primary Examiner
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